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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: M. OTA et al.

Serial No.: 08/816,891 ✓

Filed: March 13, 1997

For: MATRIX PANEL DISPLAY APPARATUS AND DRIVING  
METHOD THEREFOR WHEREIN AUXILIARY SIGNALS  
ARE APPLIED TO NON-SELECTED PICTURE  
ELEMENTS

Art Unit: 2675

Examiner: C. Nguyen

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REQUEST FOR ISSUANCE OF NEW OFFICE ACTION  
EITHER CONSIDERING ALL OF PENDING CLAIMS  
17-34 OR SETTING FORTH REQUIREMENT FOR  
ELECTION OF SPECIES

Assistant Commissioner for Patents  
Washington, D.C. 20231

March 5, 2003

Sir:

Reference is made to the telephone discussion between the Examiner and the applicants' representatives at the law firm indicated below during which the paper filed on August 10, 2001, and entitled "Request for Issuance of New Office Action Considering All of Pending Claims 17-34" was discussed.

During the telephone conversation the Examiner acknowledged that he is required to issue a new Office Action to replace the Office Action of August 6, 1998, pursuant to the comments in the interview summary mailed on February 8, 1999, for a telephone interview conducted on February 8, 1999, between the

applicants' representatives and SPE Richard Hjerpe (who was acting on behalf of the Examiner's SPE Steven Saras) during which the petition to the Commissioner under 37 CFR 1.181(a)(1) filed on August 17, 1998, was discussed.

During the telephone conversation the Examiner indicated that he intends to repeat the requirement for an election of species set forth in the Office Action of February 5, 1996, issued in parent application Serial No. 08/139,904 of the present Rule 62 divisional application, wherein the Examiner indicated that he considers Figs. 4, 5, 14, 17, 22, and 24 to represent patentably distinct species of the present invention, and required that one of these species be elected for prosecution on the merits.

During the telephone conversation the applicants' representatives pointed out that the applicants have been prejudiced by the now more than four-and-one-half-year delay in prosecution since the improper Office Action of August 6, 1998, was issued, and in light of this, it is the applicants' position that the Examiner should waive the requirement for an election of species and consider all of the pending claims, i.e. claims 17-34, on the merits. The Examiner said that he nevertheless intends to repeat the requirement for an election of species.

It is respectfully requested that the Examiner review this matter with his SPE Steven Saras and discuss the propriety of the Examiner repeating the requirement for an election of species in light of the prejudice to the applicants

caused by the now more than four-and-one-half-year delay in prosecution since the improper Office Action of August 6, 1998, was issued.

If it is decided that the Examiner should repeat the requirement for an election of species, the requirement for an election of species is traversed for the following reasons.

The Examiner's attention is directed to MPEP 806.04(h), Eighth Edition, August 2001, page 800-41 to 800-42, which provides as follows in pertinent part (emphasis by underlining added):

**806.04(h) Species Must Be Patentably Distinct From Each Other**

. . . .

In a national application containing claims directed to more than a reasonable number of species, the examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restriction should not be required if the species claimed are considered clearly unpatentable over each other.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

It is submitted that this portion of MPEP 806.04(h) requires that before the Examiner requires an election of species, the Examiner has actually made a separate determination that each one of the identified species is patentable over each other one of the identified species.

In the present situation, the Examiner has identified 6 species, i.e. the species of Figs. 4, 5, 14, 17, 22, and 24.

Thus, in order for the Examiner's requirement for an election of species to be proper, the Examiner is required to have actually made a separate determination that the species of Fig. 4 is patentable over the species of Fig. 5, and a separate determination that the species of Fig. 4 is patentable over the species of Fig. 14, and a separate determination that the species of Fig. 4 is patentable over the species of Fig. 17, and a separate determination that the species of Fig. 4 is patentable over the species of Fig. 22, and a separate determination that the species of Fig. 4 is patentable over the species of Fig. 24, for a total of 5 separate determinations of patentability with respect to the species of Fig. 4.

Also, the Examiner is required to have actually made a separate determination that the species of Fig. 5 is patentable over the species of Fig. 4, and a separate determination that the species of Fig. 5 is patentable over the species of Fig. 14, and a separate determination that the species of Fig. 5 is patentable over the species of Fig. 17, and a separate determination that the species of Fig. 5 is patentable over the species of Fig. 22, and a separate determination that the species of Fig. 5 is patentable over the species of Fig. 24, for a total of 5 separate determinations of patentability with respect to the species of Fig. 5.

Also, the Examiner is required to have actually made 5 similar separate determinations of patentability with respect to each of the remaining 4 species of Figs. 14, 17, 22, and 24.

The total number of separate determinations of patentability which the Examiner is required to have actually made with respect to the 6 species of Figs. 4, 5, 14, 17, 22, and 24 in order for the requirement for an election of species to be proper is 6 species x 5 separate determinations of patentability for each species = 30 separate determinations of patentability. It is not apparent from the record that the Examiner has actually made these 30 separate determinations of patentability.

Rather, it appears from the record that the Examiner has made the requirement for an election of species based solely on the Brief Description of the Drawings on pages 5-7 of the specification which indicates that Figs. 4, 5, 14, 17, 22, and 24 which the Examiner considers to represent patentably distinct species of the present invention respectively show first, second, sixth, seventh, twelfth, and thirteenth embodiments of the present invention.

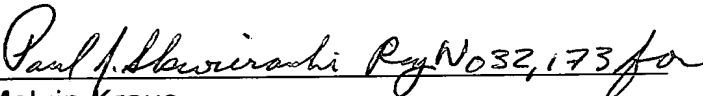
Accordingly, should the Examiner decide to repeat the requirement for an election of species, it is respectfully requested that the Examiner specifically set forth on the record the 30 separate determinations of patentability which the Examiner is required to actually make with respect to the species of Figs. 4, 5, 14, 17, 22, and 24 in order for the requirement for an election of species to be proper as discussed above.

However, it is submitted that the amount of work required for the Examiner to actually make and set forth these 30 separate determinations of patentability would far exceed the amount of work required for the Examiner to simply consider all of the pending claims, i.e. claims 17-34, on the merits. Accordingly, in light of this, it is respectfully requested that the requirement for an election of species be waived, and that all of the pending claims, i.e. claims 17-34, be considered on the merits.

It is respectfully requested that a new Office Action be issued as soon as possible, and that the new Office Action either (1) consider all of pending claims 17-34 or (2) set forth a requirement for an election of species together with an explanation of why the requirement is being made despite the arguments set forth above pointing out why the requirement should be waived.

Respectfully submitted,

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